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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,102

06/19/2006

Thomas Klettke

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EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

06/29/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/564,102	Applicant(s) KLETTKE ET AL.	
	Examiner Tae H. Yoon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-15, 17, 19, 21, 23 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-15, 17, 19, 21, 23, 25-28 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The claims 17, 19, 21, 23 and 25 are not commensurate in scope with an enabling disclosure until the named groups for “substituted” in said claims as described in the instant specification, are recited in the claims for “substituted”. If there are no examples for “substituted”, in the instant specification, “substituted” must be cancelled because the specification is not enabling for the skilled artisan to practice the invention. It would require undue experimentation to determine all of the groups which are encompassed by “substituted” and how to attach these groups to the claimed compound.

Rejection is maintained with following response.

The examiner sees that the incorporated US 4,167,618 teaches various substituent groups, but applicant also asserts that the present invention is not limited to those specific substituted alkyl sulfonium salts in said US 4,167,618.

This is exactly what the Examiner is concerned about since one does not know what other substituent groups would fall within scope of the recited “substituted”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited “more than about” is indefinite. It has to be either “about” or “more than”. See *Amgen, Ins. V. Chugal Pharmaceutical Co., Ltd.*, 18 USPQ 2d 1016 (Fed. Cir. 1991). Cancellation of “about” is suggested.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-15, 17, 19, 21, 23, 25-28 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhardt et al (US 2003/0153726 A1) in view of Schmitt et al (US 4,167,618).

Rejection is maintained for reason of record with following response.

Again, an amount of the diluents (0-70 wt.%) which overlapped the amount of the cancelled original claim 4 (about 0.01% by weight to about 20.00% by weight). Also, said 0-70 wt.% would encompass the newly recited about 0.01% by weight to about 6.0% by weight. There is no disclosure that said about 0.01% by weight to about 6.0% by weight would provide any unexpected result over now cancelled about 0.01% by weight to about 20.00% by weight which overlaps a large portion of said 0-70 wt.%. Applicant asserts that Eckhardt et al teach amides of alkylsulfonic acids and arylsulfonic acids, but fail to teach the instant amides, as the inert diluents, but how one calls the same compound is immaterial since one can be his own lexicographer. Very limited

choice would be at least a *prima facie* obviousness. See *In re Arkley*, 455 F2d 586, 172 USPQ 524 (CCPA 1972); *In re Petering*, 301 F2d 676, 133 USPQ 275 (CCPA 1962).

Any single prior art reference that falls within each of the ranges would be at least a *prima facie* obviousness. (overlapping ranges). *Atlas powder v. IRECO*, 51 USPQ 2d, 1943 (or 190 F.3d 1342, 1346) (Fed. Cir. 1999). The existence of overlapping or encompassing ranges shifts the burden to the applicant to show that his invention would have not been obvious. *In re Peterson*, 315 F.3d at 1330 (Fed. Cir. 2003).

Applicant asserts and requests that the examiner should point to the blaze marks in the cited documents, either explicit or implicit, or anywhere in the general knowledge of one skilled in the art. The examiner stated that a point here is whether Eckhardt et al teach the use of amides of alkylsulfonic acids and arylsulfonic acids or not, and the answer would be “yes”. The next point is whether choosing the instant formulas would be obvious or not, and the answer would be “yes” also.

In response to the examiner’s reasoning, **applicant stated and admitted that amides of alkylsulfonic acids and arylsulfonic acids does not only comprise amides having an SO₂-NHR group, but also amides comprising an SO₂-NH₂ group or SO₂-NR₂ group, wherein R is different from H in the second page of the response filed on December 14, 2009.** Thus, such statement by applicant would be the blaze marks. Furthermore, the instant compound (b) with different variables would encompass thousands compounds, if not millions, and thus it is not like that narrow species are claimed as asserted by applicant.

Now, applicant asserts that the Entry 15 is less effective based on the Shore-A-Hardness after 6, 8 and 10 minutes (**when an early high Shore Hardness A is desired**) and that the examiner failed to properly consider “early setting”, but claims do not have any limitation with respect to said Shore-A-Hardness after 6, 8 and 10 minutes or particular “early setting” (**a particular value of an early high Shore Hardness A is not claimed limitation**). In other words, Applicant failed to show that said Shore-A-Hardness after 6, 8 and 10 minutes of Entry 15 is detrimental. **Again, a comparison must be based on the closest prior art and not on applicant’s own choice,** especially in view of the fact that the instant claim recites “comprising” which permits presence of other components such as **antacid-acting compound** taught by Eckhardt et al. The transitional term “comprising” is an “open” term, in the sense that it leaves the claim open for the inclusion of unspecified ingredients, “even in major amounts.” *Ex parte Davis and Tuukkanen*, 80 USPQ 448, 450 (BPAI 1948). See also *North Am. Vaccine, Inc. v. American Cyanamide Co.*, 7 F.3d 1571, 1585 (Fed. Cir. 1993). Because the term “comprising” is one of enlargement, it can cause a claim to be broader than the invention. See *In re Fenton*, 451 F.2d 640, 642 (CCPA 1971).

Given probative value to the data in table on page 19 of the response, scope of claim is broader than actual showing since entries 13-15 use a particular amount of the compound (b). Whether an applicant seeks to establish an unobvious difference to overcome an inherency finding or unexpectedly improved results to overcome an obviousness conclusion, the objective evidence an applicant provides must be commensurate in scope with the claims which the evidence is offered to support. In

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other words, the showing must be reviewed to see if the results occur over the entire claimed range. *In re Marosi*, 710 F.2d 799, 803 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035-36 (CCPA 1980); *In re Peterson*, 315 F.3d 1325, 1330-31 (Fed. Cir. 2003); *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983).

Also, said “early setting” (or “enhancing setting speed” of claim 14) is vague and relative term absent further limitations since it could be 10 or 30 minutes, for example.

Rejections based on Zech et al are withdrawn since they are redundant.

Claim 29 utilizing p-toluene moiety is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
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THY/June 22, 2010